

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

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NOV 18 2002

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DALE BURNS

Appeal No. 2002-1664
Application No. 09/182,033

ON BRIEF

Before FRANKFORT, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 30 to 49, which are all of the claims pending in this application.¹

We AFFIRM-IN-PART.

¹ Claim 41 was amended subsequent to the final rejection.

BACKGROUND

The appellant's invention relates to the distribution, redemption, authentication and clearing of coupons (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

Claims 30 to 49 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the appellant, at the time the application was filed, had possession of the claimed invention.

Claims 30 to 49 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 4,882,675 to Nichtberger et al. (Nichtberger) in view of U.S. Patent No. 5,822,735 to De Lapa et al. (De Lapa).

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections², we make reference to the answer (Paper No. 19, mailed December 4, 2001) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 18, filed September 10, 2001) and

² The examiner's rejection of claims 30 to 49 under 35 U.S.C. § 112, second paragraph, made in the final rejection was withdrawn by the examiner in the answer (p. 15).

reply brief (Paper No. 20, filed February 4, 2002) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Initially we note that the objection to the drawings under 37 CFR § 1.83(a) made by the examiner in the final rejection and repeated on pages 3-4 of the answer relates to a petitionable matter and not to an appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. Accordingly, we will not review the issue raised by the appellant on page 14 of the brief and pages 3-4 of the reply brief.

The written description rejection

We will not sustain the rejection of claims 30 to 49 under 35 U.S.C. § 112, first paragraph.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

The examiner determined (answer, pp. 4-5) that the following two clauses lack written description support in the original disclosure: (1) "wherein said at least one means for each consumer to enter unutilized coupon information from printed coupons is the only means provided for consumers to add unutilized coupon information into their consumer account" (claim 30); and (2) "wherein consumers are limited to adding unutilized coupon information into their consumer account solely from printed coupons in their possession" (claim 40). We do not agree.

In our view, the application as originally filed reasonably conveys to the artisan that the inventor had possession of the above-quoted subject matter. We reach this conclusion based upon (1) the definition of coupon as set forth on page 6 of the specification (i.e., the term coupons shall mean "any mode of communication with a

consumer or a potential consumer offering a specific discount to the consumer wherein the consumer needs to bring such proof back to a store for redemption"³; and (2) the claimed electronic coupon process/system is "for eliminating a presentation of printed coupons at a checkout register." Thus, we understand the claimed subject matter quoted in the preceeding paragraph to mean that consumers can only add unutilized coupon information from printed coupons which the consumer brings into the store for redemption into their consumer account via the at least one means separate from a checkout register. The consumer enters the unutilized coupon information from the printed coupons into the associated consumer account based on input of the consumer's consumer identification means so as to eliminate any need to present the printed coupons at a checkout register.

For the reasons set forth above, the decision of the examiner to reject claims 30 to 49 under 35 U.S.C. § 112, first paragraph, is reversed

³ By defining the term coupon in such a manner, the appellant has eliminated other types of coupons (such as the electronic coupons offered in Nichtberger's system), since a coupon, by the appellant's definition, must be capable of being brought into the store with the consumer for redemption, not offered in the store for redemption.

The obviousness rejection

We sustain the rejection of claims 30 to 37, 39 to 47 and 49 under 35 U.S.C. § 103, but not the rejection of claims 38 and 48.

Claim 30

Claim 30 reads as follows:

An electronic coupon processing system for eliminating a presentation of printed coupons at a checkout register, comprising:

a plurality of consumer identification means wherein each consumer identification means is associated with a consumer;

a plurality of consumer accounts associated with said plurality of consumer identification means;

a database for storing information for each of said plurality of consumer accounts;

at least one means separate from a checkout register for each consumer to enter unutilized coupon information from printed coupons in the consumer's possession into said associated consumer account based on input of the consumer's consumer identification means so as to eliminate any need to present printed coupons at a checkout register;

at least one checkout register capable of collecting a consumer's purchase information, said register additionally being connected to said database;

means associated with said checkout register for reconciling the unutilized coupon information in each consumer's consumer account with the consumer's purchase information based solely on input of said consumer's consumer identification means; and

means for updating said consumer's consumer account to reflect utilization of coupons,

wherein said at least one means for each consumer to enter unutilized coupon information from printed coupons is the only means provided for consumers to add unutilized coupon information into their consumer account.

Nichtberger's invention relates to a highly-effective and efficient method and apparatus whereby coupons (such as cents-off merchandise coupons) can be distributed, redeemed and cleared electronically. Figure 1 shows an operations center 8 which cooperates with a plurality of local stations 10. Each of these local stations 10 is located at a supermarket where the coupons are to be distributed and redeemed. The operations center 8 contains a data entry system 12, an image capture system 14 and a central processing unit 16. Generally, the data entry system is used to establish the database which enables card issuance and the generation (if desired) of various reports on such subjects as, for example, demographic information relating to the individuals who have redeemed the coupons. The image capture system 14 essentially is responsible for enabling video images of the coupons to be presented at the separate local stations 10. The central processing unit (CPU) 16 has a wide range of functions, generally handling the clearing process controls information flow to the local stations and in the operations center itself.

Each of the local stations 10 may be considered to consist of an automated UPC scanning checkout system 18 and a local coupon distribution and redemption (CDR) unit 20. The local CDR unit 20 presents an electronic display to the customer of the coupons which are available for redemption after the customer inserts an identification card into the unit. The identification card may include a UPC code which identifies the

user and a magnetic stripe on which information can be recorded. After inserting the identification card into the local CDR unit 20, the customer selects the coupons which he or she wishes to redeem. The CDR unit 20 records the selection and makes information identifying the customer and the selected coupons available to each of the checkout stations which comprise the checkout system 18 of the supermarket. A receipt may be printed for the user's convenience and the receipt can include for each selected coupon the product name and size, and the savings amount.

After the customer has made his or her purchases, he or she goes to one of the checkout stations and presents his or her identification card to the attendant at the station. The attendant causes the identification card to be read by a suitable card reader (such as a UPC card scanner) and the checkout system 18 then automatically credits the customer for the coupons the customer has selected where there are corresponding purchases against which the coupons are to be applied. Thereafter, information regarding the redeemed coupons is transmitted to the central processing unit 16 which then automatically debits the manufacturer who distributed the coupons and credits the supermarket corresponding to the local station 10 at which the coupon was redeemed.

Nichtberger teaches (column 29, lines 56-68) that

It is further contemplated that the CDR unit 20 may contain a scanner capable of reading paper coupons with UPC codes. After inserting the card, a customer would insert paper coupons into a slot, similar to the ones used in dollar bill change machines. The UPC code on the coupons would be read, and then would be added to the electronic list of coupons available for redemption when the card is presented at the checkout. This would integrate currently used systems into the invention while significantly improving such systems by substantially reducing redemption and clearing costs. Once inserted and read, paper coupons would be destroyed by the CDR unit.

De Lapa's invention provides a coupon system which functions as both a mechanism for gathering information regarding the characteristics of particular customers as well as means for utilizing such characteristics in order to merchandise to that consumer. This may be accomplished in a manner which not only influences the decision of the customer to purchase a particular brand but entices customers into shopping at a particular retailer. A focused coupon system is provided which is nondiscriminatory as to consumer income or minority status and which invites participation by any and all consumers, with consumers being removed from the system only upon prolonged non-use. This is accomplished in a system which provides total coupon redemption as an integral step in customary purchase checkout, with a single pass of a coupon bar code over conventional point-of-sale scanning equipment.

In the rejection of claim 30 (answer, pp. 7-9), the examiner explained how all the limitations of claim 30 were readable on Nichtberger except for the "wherein clause" (i.e., wherein said at least one means for each consumer to enter unutilized coupon information from printed coupons is the only means provided for consumers to add unutilized coupon information into their consumer account) and that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified Nichtberger's system in view of the teachings of De Lapa to arrive at the claimed subject matter (i.e., to have eliminated Nichtberger's electronic coupons and retained Nichtberger's scanning and processing of paper coupons).

The appellant argues that there is no motivation in the teachings of Nichtberger and De Lapa for a person of ordinary skill in the art at the time the invention was made to have eliminated Nichtberger's electronic coupons and thus arrive at the claimed invention.⁴ The appellant asserts that none of the cited references (i.e., Nichtberger and De Lapa) disclose that the means for each consumer to enter unutilized coupon information from printed coupons is the only means provided to consumers to add unutilized coupon information to their consumer account (i.e. the "wherein clause").

⁴ The appellant has not contested the examiner's determination that all the limitations of claim 30 up to the "wherein clause" are met by Nichtberger. However, for purposes of clarification, we point out that the claimed "at least one means separate from a checkout register for each consumer to enter unutilized coupon information from printed coupons in the consumer's possession into said associated consumer account based on input of the consumer's consumer identification means so as to eliminate any need to present printed coupons at a checkout register" is met by the above-quoted portion of Nichtberger and not the portion cited by the examiner on page 8 of the answer.

In our view, all the limitations of claim 30 are met by Nichtberger.⁵ In that regard, the "wherein clause" is met by Nichtberger due to the appellant's definition of coupon as set forth on page 6 of the specification (i.e., the term coupons shall mean "any mode of communication with a consumer or a potential consumer offering a specific discount to the consumer wherein the consumer needs to bring such proof back to a store for redemption"). The electronic coupons offered in Nichtberger's system are not coupons as that term is used in claim 30 since a coupon, by the appellant's definition, must be capable of being brought into the store with the consumer for redemption, not offered in the store for redemption as are Nichtberger's electronic coupons. The only coupons disclosed by Nichtberger that are brought into a store by the customer for redemption are the printed coupons which are scanned into the CDR unit 20 and then added to the electronic list of coupons available for redemption when the identification card is presented at the checkout. Thus, Nichtberger does disclose that the means for each consumer to enter unutilized coupon information from printed coupons (the scanner at the CDR unit 20) is the only means provided for consumers to add unutilized coupon information from printed coupons which the consumer brings into the store into their consumer account.

⁵ After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

All the limitations of claim 30 are met by Nichtberger. While this is, in effect, a holding that claim 30 is anticipated by Nichtberger under 35 U.S.C. § 102(b), affirmance of the 35 U.S.C. § 103 rejection is appropriate, since it is well settled that a disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974). Thus, the decision of the examiner to reject claim 30 under 35 U.S.C. § 103 is affirmed.

Claims 31 to 35, 37, 39 to 45, 47 and 49

The appellant has grouped claims 30 to 35, 37, 39 to 45, 47 and 49 as standing or falling together.⁶ Thereby, in accordance with 37 CFR § 1.192(c)(7), claims 31 to 35, 37, 39 to 45, 47 and 49 fall with claim 30. Thus, it follows that the decision of the examiner to reject claims 31 to 35, 37, 39 to 45, 47 and 49 under 35 U.S.C. § 103 is also affirmed.

⁶ See page 13 of the appellant's brief.

Claims 36 and 46

Claims 36 and 46 add to their respective parent claims the further limitation that aisle location for products associated with the coupon information in the consumer account is included in the printout of unutilized coupon information in a consumer's consumer account.

In the rejection of claims 36 and 46 (answer, p. 10), the examiner (1) took Official Notice that printing an aisle location on a coupon is old and well known in the art; and (2) determined that

[i]t would have been obvious to one of ordinary skilled in the art at the time the Appellant's invention was made to modify the teachings of Nichtberger to include an aisle location for products associated with said coupon information in said consumer account, because it greatly improves the efficiency of the system by providing the consumer with a coupon that contains the product location in the store which saves the consumer time in locating the product.

The appellant contests (brief, p. 21; reply brief, p. 13) the rejection of claims 36 and 46 by (1) traversing the statement of Official Notice and requesting a reference be cited; (2) arguing that the Office Notice of printing an aisle location on a coupon does not teach or suggest the claimed subject matter of providing a printout of the aisle locations for products associated with a consumer's unutilized coupon information; and (3) arguing that it is unnecessary to challenge an Office Notice that takes notice of incorrect subject matter.

The argument advanced by the appellant is unpersuasive for the following reasons.

First, a review of the record reveals that the appellant did not challenge this taking of Office Notice during prosecution before the examiner. See Answer, p. 19. Rather, the appellant argues for the first time on appeal that the examiner has not provided any authority to support the taking of Office Notice as set forth in the rejection of claims 36 and 38. In the Answer (p. 19), the examiner states that MPEP Section 2144.03 provides the following:

If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. *In re Chevernard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, applicant is charged with rebutting the well known statement in the next response after the Office action in which the well known statement was made.

In the reply brief, the appellant does not dispute that they did not seasonably challenge the statement of Official Notice made by the examiner in support of the rejection of claims 36 and 46. Absent a seasonable challenge during prosecution

before the examiner, we are obliged to take the examiner's "well known statement" as admitted prior art.⁷

Second, it is our view that under Chevernard it is necessary to seasonably challenge any taking of Office Notice even subject matter that an appellant believes is not germane to the claimed invention if the appellant wishes to prevent the "well known statement" from becoming admitted prior art. In this case, we believe the subject matter officially noted by the examiner (i.e., that printing an aisle location on a coupon is old and well known in the art) was not incorrect subject matter but the precise subject matter which the examiner believed was sufficient to have rendered the subject matter of claims 36 and 46 obvious at the time the invention was made to a person of ordinary skill in the art from the combined teachings of Nichtberger, De Lapa and the Official Notice.

Lastly, it is our opinion that the combined teachings⁸ of Nichtberger and the admitted prior art (i.e., the Official Notice that printing an aisle location on a coupon is

⁷ The two references cited by the examiner on page 20 of the answer to support the taking of Office Notice have not been applied in the rejection of claims 36 and 46 under appeal. Accordingly, these references will be given no consideration. See Ex parte Raske, 28 USPQ2d 1304, 1305 (Bd. Pat. App. & Int. 1993).

⁸ The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

old and well known in the art) would have made it obvious at the time the invention was made to a person of ordinary skill in the art to have modified the receipt of Nichtberger (which is printed for the user's convenience and can include for each selected coupon the product name and size, and the savings amount) to also include aisle locations for each item in view of the fact that it was old and well known in the art to print an aisle location on a coupon. The motivation for this modification to the receipt of Nichtberger comes from the self-evident advantage of why aisle location is printed on a coupon, that is, to assist the customer in locating the item that the coupon is for in the store.

For the reasons set forth above, the decision of the examiner to reject claims 36 and 46 under 35 U.S.C. § 103 is affirmed.

Claims 38 and 48

Claims 38 and 48 add to their respective independent claims the further limitation that Internet review of unutilized coupon information in a consumer's consumer account is provided based on input of the consumer's consumer identification means.

In the rejection of claims 38 and 48 (answer, p. 11), the examiner (1) took Official Notice that reviewing coupons through the Internet is old and well known in the art; and (2) determined that

[i]t would have been obvious to one of ordinary skilled in the art at the time the Appellant's invention was made to modify the teachings of Nichtberger to include the use of Internet to review unutilized coupon information in a consumer's consumer account based on input of said consumer's consumer identification means, because it provides convenience to the user by allowing the user to access various supermarket CDR units, and review, select, and retrieve coupon information directly from the operations center.

The appellant argues (brief, p. 22; reply brief, p. 14) that the rejection of claims 38 and 48 is in error since the claimed subject matter of means for providing Internet review of unutilized coupon information in a consumer's consumer account based on input of the consumer's consumer identification means is not suggested by the Office Notice of reviewing coupons through the Internet. We agree.⁹ In our view, the only suggestion for modifying Nichtberger in the manner proposed by the examiner to meet the limitations of claims 38 and 48 stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for

⁹ The reference cited by the examiner on page 21 of the answer to support the taking of Office Notice have not been applied in the rejection of claims 38 and 48 under appeal. Accordingly, this reference will be given no consideration. See Ex parte Raske, supra.

example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 38 and 48 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 30 to 49 under 35 U.S.C. § 112, first paragraph, is reversed; the decision of the examiner to reject claims 30 to 37, 39 to 47 and 49 under 35 U.S.C. § 103 is affirmed; and the decision of the examiner to reject claims 38 and 48 under 35 U.S.C. § 103 is reversed.

AFFIRMED-IN-PART

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